

The Honorable Robert S. Lasnik

UNITED STATES DISTRICT COURT  
WESTERN DISTRICT OF WASHINGTON AT SEATTLE

RADIO SYSTEMS CORPORATION and  
INNOTEK, INC.,

Plaintiffs,

vs.

TOM LALOR, individually, and BUMPER  
BOY, INC.,

Defendants.

Case No. 2:10-cv-00828 RSL

**PLAINTIFFS' MOTIONS IN LIMINE**

NOTE ON MOTION CALENDAR:  
November 18, 2011

**I. INTRODUCTION**

Plaintiffs Radio Systems Corporation ("Radio Systems") and Innotek, Inc., ("Innotek")  
(collectively "Plaintiffs") hereby move *in limine* as follows:

**II. MOTION TO EXCLUDE THE TESTIMONY OF MARK R. HENNINGS**

The Court should exclude the testimony of Mr. Hennings about Plaintiffs' alleged  
infringement or as to any other topic at trial. Mr. Hennings is not qualified under Rule 702 of the  
Federal Rules of Evidence to provide scientific, technical, or other specialized knowledge that  
will assist the trier of fact to understand the evidence or to determine any fact in issue.

## A. Background

U.S. Patent No. 6,830,014 (“’014 Patent”), Exhibit A<sup>1</sup> and U.S. Patent No. 7,267,082 (“’082 Patent”), Exhibit B, at issue relate to animal collars of the type having one or more electrodes that protrude from the inside surface of the collar for contacting the neck of the animal. Id. Only Claims 1, 4, 5, 7, 16, 17 and 18 of the ‘014 Patent, and Claims 1, 3, 4, 6, 15 and 17 of the ‘082 Patent are at issue. Exhibit A and B. Although the claims at issue require the animal collar to include one or more electrodes, and in some claims a receiver and stimulating unit, the claims at issue are directed primarily at the configuration of the collar housing. There is no requirement in the claims at issue for specific electronic circuitry.

The Defendants have submitted the EXPERT REPORT OF MARK R. HENNINGS, J.D., M.E.S., B.S., REG. PATENT ATTY (hereinafter the “HENNINGS REPORT”), Exhibit C, and have identified Mr. Hennings as an expert witness at trial. As set forth in the HENNINGS REPORT, at 1-2, and in his curriculum vitae attached thereto, Mr. Hennings’ undergraduate degree was in general biology, and he did not work in the biological sciences thereafter. HENNINGS DEPO., at 18, ll. 2-10, Exhibit D. After college, until about 1998, Mr. Hennings’ education and employment focused on computer science and digital electronics. HENNINGS REPORT, p. 1-2, CURRICULUM VITAE, Exhibit C. He obtained a law degree in 2000, and became a practicing patent attorney primarily drafting and prosecuting patent applications in the field of computer science. Id. Mr. Hennings has alleged his computer science and digital electronics background is of some relevance to the issues before this Court; however, he has conceded that an in-depth understanding of digital electronics is not necessary for an understanding of the technology in

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<sup>1</sup> References to Exhibits in this Section I shall be to the exhibits attached to the Declaration of Bradford R. Brittan.

1 this case. For example, he testified that it is sufficient for purpose of the infringement analysis  
 2 herein to determine that a system for generating a stimulus is present. HENNINGS DEPO., at 18,  
 3 line 1, to 21, line 3, **Exhibit D**. Moreover, none of Mr. Hennings' education or work experience  
 4 is directly related to the field of animal training collars. Id. at 21, line 11, to 23, line 13.

5 Mr. Hennings' only direct involvement with electronic animal training collars, or animal  
 6 training, resulted from his wife's dog breeding "hobby" and his father's ownership of a bark  
 7 collar. HENNINGS DEPO., at 16, line 25, to 17, line 3, & 23, line 14, to 26, line 10, **Exhibit D**.  
 8 Approximately eight years ago his wife owned two remote trainers, and his father had a bark  
 9 collar that he saw when he took care of his father's dog. Id. His dog training experience is  
 10 limited to teaching basic commands and obedience in connection with his wife's hobby. Id.

## 12 **B. Argument**

### 13 **1. In order to testify as to the issue of infringement Mr. Hennings must** 14 **qualify as an expert in the pertinent art.**

15 Judges perform a "gatekeeping role" to ensure that expert testimony admitted into  
 16 evidence is both reliable and relevant. Sundance, Inc. v. DeMonte Fabricating Ltd., 550 F.3d  
 17 1356, 1360 (Fed. Cir. 2008); see also Daubert v. Merrill Dow Pharmaceuticals, Inc., 509 U.S.  
 18 579, 597 (1993); Fed. R. Evid. 702. There is no special rule as to experts in patent cases, and  
 19 patent cases are also governed by Rule 702. Sundance, 550 F.3d at 1360. Further, the  
 20 "[a]dmission of expert testimony is within the discretion of the trial court." Acoustical Design,  
 21 Inc. v. Control Elecs. Co., 932 F.2d 939, 942 (Fed. Cir. 1991).

22 In the present case, Mr. Hennings seeks to opine as to the issue of infringement.  
 23 Infringement is an issue, however, that is analyzed from the perspective of a person of ordinary  
 24 skill in the art. Sundance, 550 F.3d at 1363. Mr. Hennings acknowledged this rule in his Report,  
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 26

1 stating that “I understand that an infringement analysis, comparing the patent claims to the  
 2 accused device, is conducted from the view point of a person having ordinary skill in the art at  
 3 the time of the invention; the art, in this case, includes the field of animal training collars.”  
 4 HENNINGS REPORT, p. 3, **Exhibit C**. It follows from this rule that one who is not of ordinary  
 5 skill in the art is unqualified to offer expert testimony on the issue of infringement. Indeed,  
 6 allowing such a person to offer testimony would be an abuse of discretion:

7 We hold that it is an abuse of discretion to permit a witness to testify as an expert  
 8 on the issues of noninfringement or invalidity unless that witness is qualified as  
 9 an expert in the pertinent art. Testimony proffered by a witness lacking the  
 10 relevant technical expertise fails the standard of admissibility under Fed. R. Evid.  
 11 702. Indeed, where an issue calls for consideration of evidence from the  
 12 perspective of one of ordinary skill in the art, it is contradictory to Rule 702 to  
 13 allow a witness to testify on the issue who is not qualified as a technical expert **in**  
**that art**. We understand that patent lawyers are often qualified to testify as  
 14 technical experts, but such a qualification must derive from a lawyer’s technical  
 15 qualifications in the pertinent art.

16 Sundance, 550 F.3d at 1363 (emphasis added). In Sundance, the proposed expert was a patent  
 17 attorney, like Mr. Hennings. His general knowledge was, however, irrelevant. On the contrary,  
 18 the court concluded his non-expert testimony would only “confuse” and “cause mischief”:  
 19 “[a]dmitting testimony from a person... with no skill in the pertinent art, serves only to cause  
 20 mischief and confuse the factfinder.” Id. at 1362. Thus, in Sundance, as here, “[u]nless a patent  
 21 lawyer is also a qualified technical expert, his testimony on these kinds of technical issues is  
 22 improper and thus inadmissible.” Id. Accordingly, Defendants must establish that Mr. Hennings  
 23 is qualified as an expert in the pertinent art. As noted above, Mr. Hennings opines that the  
 24 pertinent art “includes the field of animal training collars.” HENNINGS REPORT, p. 3, **Exhibit C**.  
 25 Mr. Hennings, has no such expert knowledge.  
 26

1                   **2. Mr. Hennings is not qualified as an expert in the field of animal training**  
 2                   **collars.**

3                   Regarding who would qualify as an expert in the “field of animal training collars,” it is  
 4 instructive to look at the level of ordinary skill in that the art. In the HENNINGS REPORT, Mr.  
 5 Hennings defines one of ordinary skill in the art as one with non-specific mechanical and/or  
 6 electrical knowledge, but he does go so far as to totally exclude a requirement for knowledge of  
 7 the animal training collar technology or the animal training collar industry. Significantly, in  
 8 trying to include himself as one of ordinary skill Mr. Hennings excluded Mr. Lalor, the inventor  
 9 of the patents-in-suit, from his definition, and in acknowledging that at least some relevant  
 10 knowledge of the industry is necessary he excluded himself from his own definition. Mr.  
 11 Hennings define one of ordinary skill in the art as follows:

12                   In this case, the person would be mechanically inclined and have a background in  
 13 packaging for packaging portable electric circuits and the needs of that industry.  
 14 This person of skill would likely have an undergraduate degree in an engineering  
 15 field such as Mechanical and/or Electrical Engineering. Such a degree indicates  
 16 knowledge and application of the basic laws of physics. This hypothetical person  
 17 would also have worked in the design-, manufacturing-, and/or service-related  
 18 areas for several years, and would understand the operation, maintenance and  
 19 servicing issues of various forms of packaging portable electronic circuits. This  
 20 person would also be aware of previous animal training devices, including  
 previous animal training collars, and market forces driving the developments in  
 the animal training collars, and would understand the basics of principles and  
 operation of electronic circuits and the physiological effects of the animal training  
 collar upon the animal wearing the collar. This person would be adept in  
 structural design.

21 HENNINGS REPORT, pp. 3-4, **Exhibit C**. The requirement for a degree in mechanical or electrical  
 22 engineering would describe Mr. Hennings, but not Mr. Lalor, who has no such degrees. It is  
 23 unlikely with his background that Mr. Lalor had at the time of the invention any significant  
 24 expertise in portable electronic circuits. LALOR DEPO., at 6, line 22, to 7, line 20, **Exhibit E**.  
 25 Accordingly, although one would think the inventor would be indicative of one skilled in the art,  
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Mr. Hennings' definition does not describe the inventor of the patents-in-suit. With respect to knowledge specific to the field of animal training collars, neither his wife's ownership of two remote trainers approximately eight years ago (likely after the date of invention in this case), nor his babysitting a dog with a bark collar would give Mr. Hennings any expertise regarding "previous animal training devices, including previous animal training collars, and market forces driving the developments in the animal training collars." And, Mr. Hennings' teaching of basic commands in connection with his wife's dog breeding hobby would have hardly given him any expertise in "the physiological effects of the animal training collar upon the animal wearing the collar." Thus, whereas Plaintiffs' disagree with Mr. Hennings' definition of one of ordinary skill in the art, it is instructive that Mr. Hennings does not meet his own criteria.

One of Plaintiffs' expert witnesses, Mr. Michael Westrick, opined that one of ordinary skill in the relevant art relating to the patents-in-suit would have "between three and five years of experience in the electronic dog collar field, including experience designing electronic animal collars." EXPERT REPORT OF MICHAEL DAVID WESTRICK PURSUANT TO FED.R.CIV.P. 26(a)(2)(B), p. 11, attached in part as **Exhibit F**. Another of Plaintiff's expert witnesses, Mr. Duane Gerig, echoed this conclusion. EXPERT REPORT OF DUANE A. GERIG PURSUANT TO FED.R.CIV.P. 26(a)(2)(B), p. 9, attached in part as **Exhibit G**. Under this definition of one of ordinary skill in the art Mr. Hennings would fall woefully short. He clearly does not qualify as an expert in the field of animal training collars under any definition.

**3. Prior to opining on infringement Mr. Hennings made no effort to make himself aware of the state of the art at the time of the invention.**

This is not merely a case where Mr. Hennings does not qualify by training or experience as an expert in the field of animal training collars. It is also a situation where Mr. Hennings has

1 made no effort to educate himself as to the technology at the time of the invention, and  
2 Defendants' counsel has made no effort to assist him in that regard.

3 Mr. Hennings acknowledged that an infringement analysis is conducted from the view  
4 point of a person having ordinary skill in the art at the time of the invention, which necessarily  
5 requires one to have an understanding of the state of the art at the time of the invention.  
6 HENNINGS REPORT, p. 3, Exhibit C. However, Mr. Hennings reviewed only two of the twenty-  
7 four patents cited by the examiner during the prosecution of the patents-in-suit. HENNINGS  
8 DEPO., at 30, line 16, to 33, line 4; 37, line 10, to 38, line 6; 87, line 3, to 91, line 3, Exhibit D.  
9 He stated that he conducted a patent search for prior art patents, but he used a database that  
10 would not allow him to see the drawing of the patents being reviewed. Id. at 33, line 5-10; 34,  
11 line 13, to 37, line 9; 87, ll. 15-18. Thus, he would not have been able to view patent drawings  
12 which would have shown the configuration of the collar housing of the prior art patents. Id.  
13 Such a search would have been meaningless given the technology at issue in this litigation.  
14

15 What is particularly disturbing in this case is that Defendants' counsel made no effort to  
16 assist Mr. Hennings to understand the state of the art at the time of the invention. Throughout  
17 this litigation numerous prior art references have been cited, including numerous references cited  
18 in PLAINTIFFS' PRELIMINARY INVALIDITY CONTENTIONS, served on November 9, 2010, and  
19 numerous prior art references cited in the claim construction briefs filed last spring. These  
20 references include U.S. Patent No. 5,872,516 to Bonge, U.S. Patent No. Des. 330,173 to Juliana  
21 et al., and other references that are the focus of Plaintiffs' pending motion for summary  
22 judgment. Although access to such references would not have made up for his basic lack of  
23 expertise in the animal training collar field, it would have at least given Mr. Hennings some idea  
24 of the technology at the time of the alleged invention. However, Mr. Hennings testified in his  
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1 deposition on October 14, 2011, that he had not seen these very significant references.  
2 HENNINGS DEPO., at 46, line 18, to 47, line 6; 53, ll. 16-24; 55, ll. 5-20; 96, line 23, to 98, line 7;  
3 103, line 24, to 106, line 7; 114, line 23, to 117, line 12; 121, ll. 6-12, Exhibit D. Indeed, Mr.  
4 Hennings testified as follows:

5 Q. You opined in your report, did you not, that one skilled in the art  
6 would know the state of the art at the time of the invention; is that correct?

\* \* \* \*

7 THE WITNESS: Can you read that question to me, please, again. (Last  
8 question read.)

9 A. (Witness reviews document.) No, I stated the - - I stated that the  
10 infringement analysis is conducted from the viewpoint of a person having  
ordinary skill in the art.

11 Q. At the time of the invention?

12 A. At the time of the invention, right.

13 Q. Would that not suggest that one of ordinary skill in the art needs to  
14 know what the art was at the time?

15 A. Not necessarily, but yes.

16 Q. Yet, you reviewed two prior art references.

17 A. Mm-hum.

18 Q. Were you aware that your attorneys or Mr. Lalor's attorneys were  
19 in possession of every reference that we have used in this deposition today?

20 A. I was not aware of that.

21 Q. Okay. Yet none of these references were seen by you when you  
22 did your report? I think you testified that the Farkas - -

23 A. Right. Yeah, the Farkas and I believe there is one other I looked  
24 at, the ones that the patent examiner thought were most relevant.

25 Q. Okay. So you looked at two references and all the others that we  
26 have talked about today were in the possession of Mr. Lalor's counsel?



1 MR. WHITAKER: Objection. Speculation.

2 A. I don't know that, but - - that they were in possession of the. I  
3 have seen indications today that at least some of them were, so... (Pause.)

\* \* \* \*

4 Q. Well, would it be your testimony then that you could testify from  
5 the view point of one of ordinary skill in the art at the time of the invention  
6 without knowing what the level of - not knowing the technology at the time?

7 THE WITNESS: Read the question to me, please. (last question read.)

8 A. No.

9 HENNINGS DEPO., 136, line 19, to 139, line 19, **Exhibit D**. Given his lack of expertise in the art,  
10 one would think Mr. Hennings would have made some meaningful effort to enlighten himself as  
11 to the state of the art before submitting his opinions by way of a report. One would also have  
12 think Lalor's counsel would have assisted in this regard. However, neither effort was made.

13 The Federal Circuit has stated that "[a]llowing a patent law expert without any technical  
14 expertise to testify on the issues of infringement and validity amounts to nothing more than  
15 advocacy from the witness stand." Sundance, 550 F.3d at 1365-66. At the time of the alleged  
16 inventions of the patents-in-suit, Mr. Hennings was a patent attorney writing and prosecuting  
17 computer related patent applications. He has no experience in the animal training collar industry,  
18 and his personal experience with training collars are no more than the average training collar  
19 owner. Moreover, he made no meaningful effort to educate himself regarding the technology at  
20 the time of the alleged invention. Mr. Hennings is not one of ordinary skill in the art, and he is  
21 not qualified to give expert testimony regarding infringement or validity issues in this case.  
22 Allowing him to testify would allow advocacy from the witness stand.

### III. MOTION TO EXCLUDE THE TESTIMONY OF SCOTT CRAGUN.

The Court should also exclude the opinion of Scott Cragun. “[A]n expert’s testimony shall be limited in substance to what he considered in his opening report. Thereafter, the expert cannot fix its deficiencies.” Luke v. Family Care & Urgent Med. Clinics, 323 Fed. Appx. 496 (9<sup>th</sup> Cir. 2009); Cooper Tire & Rubber Co. v. Farese, 2008 U.S. Dist. LEXIS 96729 (N.D. Miss. Nov. 26, 2008); Keytrack, Inc. v. Key Register LLC, No. C-03-00870 WHA, 2004 WL 2944043, at \*3 (N.D. Cal. Mar. 30, 2004). Mr. Cragun’s opinion does not meet the required standards set forth in either Rule 702 or Rule 26(a)(2)(B)(i) and he cannot rehabilitate himself at trial.

#### A. Mr. Cragun’s Opinion is Unsupported, Improper, and Flawed, and it Would Not Be Helpful to the Jury.

##### 1. Mr. Cragun did not adequately state the basis of his opinion.

Mr. Cragun’s testimony should be excluded because he failed to state the basis and reasons for his opinion in his expert report as required by Rule 26. Although he purports to analyze the facts under the factors set forth in Georgia Pacific Corp. v. United Plywood Corp., 318 F. Supp. 1116 (S.N.D.Y. 1970), modified and aff’d, 446 F.2d 295 (2d Cir. 1971), he offers only a recitation of alleged facts, coupled with conclusory statements that he has “considered” the facts in arriving at his opinion. *See e.g.* Culbert Decl. II, Exh. A (Cragun Report at 12, 14, 16, 18-20)<sup>2</sup>. There is nothing in Mr. Cragun’s opinion that adequately explains how his royalty rate was derived. As a result, and because his opinions would be confined to the content of his

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<sup>2</sup> The report is attached as Exhibit A to the Declaration of Regina V. Culbert in support of Motion to File Under Seal (Culbert Decl. II). Because Mr. Cragun’s report and deposition discusses confidential financial and licensing information from Radio Systems and Innotek, it has been designated “Attorneys Eyes Only.” Accordingly, this Motion will discuss the issues generically, without reference to specific numbers. Plaintiffs are seeking leave of Court to file Mr. Cragun’s report and portions of his deposition testimony under seal, pursuant to Local Rule 5(g).

expert report, any testimony he would offer at trial would also be superficial and vague. Thus his testimony should be excluded under both Rule 702 and Rule 37(C)(1).

## 2. Mr. Cragun's opinion improperly compares multi-component systems.

The patentee bears the burden of proving damages, and those damages must at all times relate to the economic harm caused by the alleged infringement. Lucent Techs., Inc. v. Gateway, Inc., 580 F.3d 1301, 1324 (Fed. Cir. 2009). "To prevent the hypothetical [negotiation] from lapsing into pure speculation" sound economic proof of the nature of the market and the likely outcomes with infringement factored out of the economic picture is required. ResQNet.com, Inc. v. Lansa, Inc., 594 F.3d 860, 868-69 (Fed. Cir. 2010). The trial court must ensure that proof of damages is carefully tied to the claimed invention's footprint in the market place. Id. at 869.

Mr. Cragun purports to compare the profitability of the accused products with non-accused products, in order to determine the portion of profit associated with the technology of the Lalor patents. Cragun Report at 14-15, 19-20. Rather than properly limiting his analysis to the accused collars, however, Mr. Cragun assessed multi-component pet containment and remote training *systems* containing other products. *See e.g.* Cragun Report at 13-14.

Mr. Cragun's reliance on system prices for purposes of determining a reasonable royalty for a collar patent is inappropriate. Uniloc USA, Inc. v. Microsoft, 632 F.3d 1292, 1318 (Fed. Cir. 2011) (patentee must separate portion of profit and patentee's damages between patented feature and unpatented features; such evidence must be reliable and not speculative). Mr. Cragun admitted that he made no effort to separate the profit from the collars contained in the systems. Cragun Dep. at p. 73, 74<sup>3</sup>. There is no evidence that the demand for the accused

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<sup>3</sup> Portions of Mr. Cragun's deposition testimony are attached as Exhibit B to Culbert Decl. II.

remote training devices and pet containment systems was driven by the purported improvements embodied in the Lalor patents. See Cragun Dep. at p. 83. This portion of Mr. Cragun's analysis is faulty and renders his report unreliable.

**3. Mr. Cragun's opinion compares the prices of accused and non-accused product pairs that are not proper to compare.**

Mr. Cragun also purports to compare the prices and profitability of accused products versus non-accused products, purporting to opine on whether consumers pay a premium for the technology provided by the Lalor patents. Cragun Report at 19-20. However, with one exception, the non-accused products he compares to the accused products have many other features that have nothing to do with the Lalor patents. Mr. Cragun even admitted at deposition that he did not have the proper cost data to do an appropriate comparison, and that because of the differences in the products, his product pairs were "not an adequate comparison." See Cragun Dep. at 69-70, 74-78. Mr. Cragun has not updated, supplemented or corrected his report. His use of an improper analysis renders his opinion unreliable.

**4. Mr. Cragun relies on license agreements that do not relate to the technology in the patents at issue.**

Mr. Cragun's opinion is also unreliable because he bases it on the royalty rates reflected in license agreements that do not relate to the patents at issue in this case. In this regard, it would be error to admit his testimony. ResQNet, 594 F.3d at 871 (quoting Lucent v. Microsoft, 580 F.3d at 1328 ). This is because the analysis will not reflect the patented invention's footprint in the marketplace and instead reflects royalties paid for totally different products. See id. at 869.

In his report, Mr. Cragun purports to acknowledge the differences in the license agreements, but he never explains why they are relevant. Cragun Report at 12. He even admitted that six out of the eight licenses he relied upon were "less comparable" to the Lalor

1 patents at issue. Cragun Dep at 61,64-65, 66. This kind of analysis that was soundly rejected as  
 2 “speculative and unreliable” by the Federal Circuit in ResQNet. See 594 F.3d at 871.

3 **5. Mr. Cragun relies on website prices instead of actual dollars received.**

4 Mr. Cragun’s opinion is unreliable because of the way he calculates Defendants’ alleged  
 5 profits from the sale of accused products. Instead of relying on actual dollars received, he used  
 6 prices quoted from Defendants’ website. *See e.g.* Cragun Report at 19. As Plaintiffs’ expert will  
 7 show, this inflates the alleged profit by a factor of two. The result is that Mr. Cragun’s opinion is  
 8 not tied to the patents’ actual footprint in the marketplace. Thus, his opinion is unreliable.  
 9

10 **D. Mr. Cragun’s Opinion is Misleading.**

11 **1. Mr. Cragun misleadingly implies that there is a customary (large) royalty  
 12 paid for the technology at issue.**

13 Mr. Cragun misleading implies in his report that there is a customary (large) royalty paid  
 14 for the technology at issue. He does this by mentioning a license unrelated to the patented  
 15 technology that provided for an up-front payment of \$1 million dollars to the patentee. He does  
 16 this notwithstanding his conclusion that he is not aware of any customary royalty rates for the  
 17 patented technology. Cragun Report at 18. This improper advocacy is misleading.

18 **E. Mr Cragun Should Be Precluded From Testifying That He Did Not Receive  
 19 Documents Until it was Too Late to Include An Analysis of Them in his Report.**

20 Mr. Cragun excused his flawed analysis by noting that he did not receive the appropriate  
 21 documents. Cragun Dep. at p. 68. Defendants did not ask Plaintiffs to provide the information he  
 22 mentioned, and Culbert Decl. at Exh. 5 (discovery requests directed to “Animal Collars” defined  
 23 as the accused products only, not all products), and Mr. Cragun had the opportunity to submit a  
 24 rebuttal or supplemental report but did not. Similarly, Mr. Cragun testified that he did not  
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1 receive a relevant license agreement until it was too late, but the cause of the delay was not due  
2 to Plaintiffs. *See* Culbert Decl. at ¶7 (explaining facts).

#### 3 IV. MOTION TO LIMIT TESTIMONY FROM MR. LALOR.

4 The Court should limit the testimony of Mr. Lalor to factual matters. Mr. Lalor neither  
5 disclosed himself as an expert witness pursuant to Rule 26(a)(2)(A), nor provided a written  
6 report or disclosure pursuant to Rules 26(a)(2)(B)-(C). Further, by his own admission, he is not  
7 qualified to give expert testimony in this matter.

8 The Rules clearly require the exclusion of undisclosed expert testimony: “If a party fails  
9 to provide information or identify a witness as required by Rule 26(a) or (e), the party is not  
10 allowed to use that information or witness to supply evidence . . . at a trial, unless the failure was  
11 substantially justified or is harmless.” Fed. R. Civ. P. 37(c)(1). Neither exception to this Rule is  
12 applicable here. Mr. Lalor clearly took the position that he was “not an expert” with respect to  
13 the patents-in-suit. It would be manifestly unjust to allow him to testify as an expert now.

14 Further, as stated above, Rule 702 allows expert testimony only where the witness is  
15 “qualified as an expert by knowledge, skill, experience, training, or education.” Fed. R. Evid.  
16 702. The objective of this Rule is “to ensure the reliability and relevancy of expert testimony,”  
17 whether it comes from “professional studies or personal experience.” *Kumho Tire Co., Ltd. v.*  
18 *Carmichael*, 526 U.S. 137, 152 (1999). Nothing in the record even remotely suggests that Mr.  
19 Lalor satisfies the Rule 702 factors. He has no training or educational background that would  
20 enable him to testify as an expert based on professional studies, and he lacks any particular  
21 knowledge or skill that would qualify him based on personal experience. He is an ideas man  
22 who turned over his conception to others to reduce to practice. To the point: He testified that he  
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1 lacks relevant or reliable knowledge on the very subjects about which he professed to have  
2 discoverable information in his Initial Disclosures.

3 Mr. Lalor proposes calling himself to testify about “the contents and scope” of the  
4 patents-in-suit, as well as about “the dog training collar industry” and “the operations and  
5 business dealings of those engaged in the industry.” *See* Defendants’ Pretrial Statement, at 4-5  
6 (excerpt attached as Exhibit 1 to the Declaration of Regina V. Culbert (“Culbert Decl.”)). Mr.  
7 Lalor similarly identified himself on his Initial Disclosures as an individual likely to have  
8 discoverable information about “the terminology used in the ‘014 and ‘082 Patents and . . . the  
9 construction of such terminology by those skilled in the art.” *See* Defendant/Counter-Claim  
10 Plaintiff’s Initial Disclosures, at 2 (emphasis added) (excerpt attached at Culbert Decl., Exh. 2.)  
11

12 Yet at his deposition, Mr. Lalor testified that he had knowledge only of the premise of the  
13 patents-in-suit, but that he was “not an expert” with respect to the patents’ contents and scope:

- 14 • ***“I’m not an expert*** at the patent claims. The only thing I understand is basically,  
15 you know, the premise of the collar and how it works on the dog . . . .”  
16 Deposition of Thomas M. Lalor (“Lalor Dep.”), at 26 (excerpts attached at  
Culbert Decl., Exh. 3) (emphasis added).
- 17 • “You know, you’re asking me to go through what’s been written here and ***I’m not***  
18 ***an expert*** at how this all goes together with all the things in it.” *Id.* at 79  
(emphasis added).
- 19 • ***“I’m not an expert*** of defining what surfaces and the minutia of these things.” *Id.*  
20 at 80 (emphasis added).

21 Mr. Lalor repeatedly emphasized that he relied on his patent attorney to translate his  
22 conception into claims, “I just explained to the patent lawyer how it worked. He devised the  
23 claims in accordance and I think it’s quite explained in it [sic]. I don’t think I can explain it any  
24 better. That’s what I hired him to do.” *Id.* at 77. He also testified, “I just know how the unit  
25 works. I don’t know the definition of it. That’s what I gave the patent lawyer to do is to define  
26

1 it.” *Id.* at 89. And, in fact, his counsel stated, “[H]e is not here as an expert in interpretation of  
 2 patent claims and so forth.” Lalor Dep., at 25. At most, therefore, Mr. Lalor may be competent  
 3 to testifying about his conception of the invention described or claim in the ‘014 and ‘082  
 4 Patents; however, he is not competent to testify about the content and scope of the patents.

5 Mr. Lalor is not competent to testify about the terminology used in the ‘014 and ‘082  
 6 Patents, much less the construction of such terminology by those skilled in the art. For example,  
 7 he admitted that he did not understand the term “electrode base” or its construction:

8 Q: So you don’t understand what the electrode base is?

9 A: Not in the way that may be explained in here [referring to  
 10 the ‘014 Patent].

11 *Id.* at 79; *see also id.* at 85 (“I don’t know what electrode base means unless I look at the  
 12 definition of it.”). Likewise, he could not identify where the high-point surfaces were without  
 13 first studying the patents:

14 Q: Referring to the same figure, where would the high-point  
 15 surfaces be?

16 A: Well, again, I have to read how it’s – the context of high-  
 17 point surfaces. I haven’t read this in seven years.

18 *Id.* at 86.

19 Mr. Lalor’s lack of understanding of the terminology used in his own patents, let alone  
 20 the scope and content of those patents, is remarkable. Given his lack of knowledge, coupled  
 21 with his failure to comply with Rule 26(a)(2) and his lack of qualifications under Rule 702 and  
 22 *Daubert*, the Court should limit his testimony to factual matters.



**V. MOTION TO PRECLUDE TESTIMONY FROM NUNN, XIONG AND ROBINS**

Mr. Lalor proposes calling Dennis Robins (“Mr. Robins”) and Murry Nunn (“Mr. Nunn”) to testify solely about “Mr. Lalor’s conception, design and development of the inventions claimed in the ‘014 and ‘082 Patents.” Defendants’ Pretrial Statement, at 6 (excerpt attached at Culbert Dec., Exh. 1). Mr. Lalor failed to identify either Mr. Robins or Mr. Nunn in response to Radio Systems’ Interrogatory No. 1, which asked him not only to identify “all persons involved in any way with the conception, development, design, and/or actual reduction to practice of the alleged inventions described and claimed in the patents-in-suit,” but also to “describe the role of each such person.” Defendants’ Responses to Plaintiff Innotek, Inc.’s First Set of Interrogatories to Mr. Lalor, No. 1 (excerpt attached at Culbert Decl., Exh. 2). Having failed to identify either man in response to this interrogatory and, more consequentially, having failed to describe either man’s role in the conception, development, design, or reduction to practice of the alleged inventions, Mr. Lalor should not now be allowed to rely on Mr. Robins’ or Mr. Nunn’s testimony for the very same purpose.

Mr. Lalor proposes calling and Mr. Robins and Kenneth Xiong (“Mr. Xiong”) to testify about “the dog training collar industry and . . . “the operations and business dealings of those engaged in the industry,” and he proposes calling Mr. Xiong to testify about “the terminology used in the ‘014 and ‘082 Patents and . . . the construction of such terminology by those skilled in the art.” Defendants’ Pretrial Statement, at 6 (excerpt attached at Culbert Decl., Exh. 1). Because the identified topics involve technical and specialized knowledge beyond the ken of the ordinary person, such testimony would constitute expert testimony under Rule 702. Yet Mr. Lalor has neither disclosed Mr. Robins and Mr. Xiong as expert witnesses, nor provided Radio Systems with expert reports stating their opinions and the facts or data he considered in forming

such opinions, as required by Rule 26(a)(2). Mr. Robins and Mr. Xiong should, therefore, be precluded from testifying as experts on any topic, pursuant to Rule 37(c)(1).

### V. CONCLUSION

For the reasons stated above, Plaintiff respectfully requests that its motions be granted. A proposed order is attached to this motion.

DATED this 7<sup>th</sup> day of November, 2011.

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**CERTIFICATE OF SERVICE**

I hereby certify under penalty of perjury that on November 7, 2011, I electronically filed the foregoing with the Clerk of the Court using the CM/ECF system which will send notification of such filing to the following:

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